

REMARKS

Claims 29-60 are pending in this application, claims 1-28 having been cancelled by preliminary amendment. Claim 37 is amended herein.

Claims 29 and 48 are independent.

The defect in the previously filed Information Disclosure Statement (Paper No. 4) is noted. This reference is resubmitted in an Information Disclosure Statement submitted herewith.

The pending claims are the subject of an election/restriction requirement under 35 U.S.C. §121. In particular, the Examiner requires election between claims 29-47 and claims 48-60. The restriction requirement is respectfully traversed.

The Examiner argues that claims 29-47 (Group I), drawn to an electronic commerce system architecture, and claims 48-60 (Group II), drawn to a method of facilitating electronic commerce, are distinct from one another as "the process may be practiced by a materially different apparatus (e.g. one that does not require a first plurality of network servers in conjunction with second and central servers)." The Examiner further argues that the claims recite distinct inventions because "the search required for Group I is not required for Group II, and because the inventions have acquired a separate status in the art because of their recognized divergent subject matter."

It is respectfully submitted that the restriction requirement is improper. The Examiner's contention that the process may be practiced by a materially different apparatus is conclusory. The Examiner has not provided any indication as to what type of apparatus, other than "one that does not require a first plurality of network servers in conjunction with second and central servers," could be used to practice the process.

Furthermore, the Examiner's election/restriction requirement itself evidences that different searches are not required for Groups I and II and that Groups I and II have not acquired separate status in the art. The Examiner acknowledges that both Group I and Group II are classified in class 705, subclass 28. A proper search for both groups would focus on the same class/subclass (705/28), as both groups have the same status (class/subclass) in the art.

It is respectfully requested that the Examiner reconsider and withdraw the election/restriction requirement and examine each of claims 29-60.

However, in the event that the Examiner does not withdraw the restriction requirement, Group I is elected with traverse. This election is in accord with the provisional election of Group I, with traverse, made via telephone prior to February 6, 2001.

Claim 37 stands rejected under 35 U.S.C. §112, second paragraph, as being indefinite. The claim has been amended to address the Examiner's noted concern.

Claims 29-36 and 41 stand rejected under 35 U.S.C. §102(b) as anticipated by PowerTV Inc., White Paper entitled "Applications and Service Infrastructure" (hereinafter "PowerTV"). The rejection is respectfully traversed.

The pending claims in the present application are the subject of a PCT application (International application No. PCT/US00/23569) which designates the United States as an International Preliminary Examining Authority. A PCT rule 66 Written Opinion has issued from the USPTO on these identical claims indicating that the claims are novel. A copy of the Written Opinion as well as the references relied upon therein are submitted herewith under an Information Disclosure Statement. The Examiner's attention is called to the fact that

the Written Opinion is signed by Robert Olszewski, the Examiner's supervisor who signed the present Official Action. The Examiner is courteously requested to consider the USPTO's determination of the claims' novelty as found in the Written Opinion in examining the claims of the present application.

In the present Official Action, the Examiner indicates that "functional recitation(s) using the word 'to' ... have been given little patentable weight because they fail to add any structural limitations and are thereby regarded as intended use language." The Examiner bases this decision on In re Casey, 152 USPQ 235 (CCPA 1967), and In re Otto, 136 USPQ 458, 459 (CCPA 1963). It is respectfully submitted that the Examiner has misapplied these cases, and thus improperly interpreted the claims of the present application.

The Examiner's attention is courteously directed to MPEP §2111.02, "Weight of Preamble," which includes discussion of the Otto and Casey cases. These cases do not teach, as suggested by the Examiner, that functional limitations in the body of a claim are to be given little patentable weight. Rather, these cases are directed to claim interpretation in the situation in which functional language, related to structure, is contained in a preamble of a claim.

The claim language in the present application given little patentable weight by the Examiner is not found in a claim preamble. Rather, the subject language is found within the body of the claims. The Examiner's attention is further courteously directed to In re Wilson, 165 USPQ 494, 496 (CCPA 1970), and In re Oelrich and Divigard, 212 USPQ 323, 326 (CCPA 1981), which require that all words in a claim must be considered in judging patentability of a claim against prior art, including functional language.

In view of the Examiner's misapplication of Otto and Casey, and the holdings of Wilson and Oelrich, it is respectfully submitted that the Examiner has not fulfilled his duties in examining the claims of the present application by not considering functional language. Therefore, the Examiner is respectfully requested to properly interpret the claims of the present application and then examine the claims in accordance with that proper interpretation.

However, to provide a complete response to the Official Action, the Examiner's rejection of the claims, though improper as discussed above, is specifically discussed below.

Regarding independent claim 29, the Examiner contends that PowerTV teaches a first plurality of first servers, each configured to communicate with a first plurality of network devices associated with a first network, and each configured to receive a first product related request from one of the first plurality of network devices. In particular, the Examiner references the figure found on page 18 of PowerTV and argues "the first servers receive a first product related request from one of the first one of the first plurality of network devices (the user orders products or gets info via email and the world wide web ("WWW"))."

PowerTV discloses an architecture for delivering the Internet to a television, not an architecture for an electronic commerce system. It is acknowledged that PowerTV discloses a plurality of servers configured to communicate with a plurality of network devices associated with a network. However, the similarity between PowerTV and the invention of claim 29 ends there.

The page 18 figure shows a set-top box in communication with a broadcast carousel server, an email server, and an HTTP proxy server. These three servers are described on page 18.

The broadcast carousel server 'webcasts' Web content to the set-top box. The email server "provides standard email functionality." The HTTP proxy server operates in multiple modes. It "acts as a normal 'Intranet' Web Server providing a repository for primarily local content," "acts as a buffer between external Internet Web sites and the set-top" by proving "parental control, enabling ratings control on accessed content in addition to access control lists," and it provides remote browser capability.

Thus, the PowerTV servers are configured to provide Internet access to a user via a television/set-top box combination. The particular content/type of information which the user accesses via the Internet is not a subject of the PowerTV reference. In fact, PowerTV discloses a system whereby a user can access any information/content wished. Accordingly, the servers of PowerTV are not each configured to receive a first product related request from one of the first plurality of network devices, as required by claim 29. At best, the Examiner's arguments are purely speculative as to what information a user might choose to receive from, and/or transmit to, the Internet utilizing the PowerTV system.

The Examiner also contends that Power TV teaches the required second server and central server of claim 29. The Examiner argues that the second server is "a service provider webserver such as compuserve, AOL, earthlink, or mindsping or content server such as tucows.com" and that the central server is an "e-commerce web site."

First, the servers the Examiner contends are the required second server and central server are not even a part of the architecture of PowerTV. Second, these servers are not even described in PowerTV. The Examiner's contention that a second server and a central server are taught by PowerTV is simply not

supported by the reference. Again, it is respectfully submitted, the Examiner's arguments are purely speculative.

The Examiner further argues that the second server includes a first database storing first product related data, stating "to be transmitted, it is stored at least temporarily." As best understood, 'it' refers to the required product related request. Notwithstanding the fact that PowerTV does not teach or suggest a second server, let alone a second server having a first database, the Examiner's interpretation of 'database' is contrary to the meaning of 'database' as understood by one of ordinary skill in the art. Temporarily storing data during transmission is not the same as storing data in a database. A database, as will be understood by one skilled in the art, is a storage area configured to store a collection of data that can be used for more than one purpose (see Burrow's Dictionary of Computer Terms, Third Edition, Covington and Downy, 1992, ISBN 0-8120-4824-5) Furthermore, the Examiner's contention that the (untaught and unsuggested) database stores first product related data is, yet again, pure speculation.

In rejecting claim 29, the Examiner concocts an entirely speculative use of the PowerTV system based entirely upon figure 18. As best understood, the Examiner seems to argue that one of the PowerTV servers receives a product related request from a set-top box, and that server then passes the request to a service provider server or content server. The Examiner further speculates that this receiving server then transmits the request to an e-commerce web site which stores product related data such as "price, quantity, and garment size." Apparently, the Examiner further contends that this e-commerce site then transmits this information to the service provider or content server, which in turn transmits it to a PowerTV server, which then in turn transmits it to a set-top box, although this is not

discussed in the publication. It is also speculated that this e-commerce site stores sale information "for accounting purposes." It is respectfully submitted that contrary to the examiner's conclusion, the required functionality is neither taught nor suggested by PowerTV. Further, the disclosed architecture is necessarily incapable of providing this functionality because PowerTV does not disclose a second server and central server as required by claim 29.

Accordingly, for the reasons recited above, it is respectfully submitted that independent claim 29, as well as its dependences, patentably distinguishes over the applied art. The Examiner is therefore courteously requested to reconsider and withdraw the rejection of these claims.

It is also respectfully submitted that the dependencies of claim 29 further independently distinguish from the applied art. For example, claim 30 requires that each of the first plurality of servers be configured to transmit applications operable to receive the product related data. The Examiner looks to the disclosure of downloaded Java applications on page 23 of PowerTV for this feature. While it is acknowledged that PowerTV does disclose transmitting applications to set-top boxes, PowerTV does not teach or suggest each, or for that matter any, of a first plurality of servers being configured to transmit applications operable to receive product related data.

Claim 31 requires that the first product related request be either a request to purchase a product or a request for information regarding the product itself. The Examiner rejects this claim on the basis of text reading "purchase a sweater or information via compuserve." Yet again, the Examiner is speculating as to a possible use of the Internet by a user accessing the Internet via the PowerTV system. PowerTV does not teach or suggest any specific Internet service or information

accessed via the PowerTV system, let along a system configured to transmit and/or receive a product related request.

Claim 32 requires that the first product related request is receivable from and the first product related data is transmittable to the one network device only if the one network device is tuned to one of multiple broadcast channels. The Examiner points to PowerTV, page 3, and argues "the operator is allowed to choose the content of the programming." The Examiner's rejection is not understood. Page 3 of PowerTV does not in any way disclose the feature recited in claim 32. Page 3 discusses, generally, the business needs of a cable television operator. To the extent that the Examiner maintains this rejection of claim 32, it is courteously requested that the Examiner clarify the reasons for rejection.

Likewise, the Examiner's rejection of claim 33, which depends from claim 32, is not understood. Claim 33 requires that the first product related data transmitted to the one network device be viewable in conjunction with video programming broadcast over the one channel.

As best understood, the Examiner relies on the discussion of an operating system for a set-top box beneficially including support for both broadcast and two-way system service (page 12) in rejecting claim 33. However, how this disclosure could suggest transmitting first product related data to one network device viewable in conjunction with video programming broadcast over the one channel is unclear. Accordingly, to the extent that the Examiner maintains this rejection, it is courteously requested that the Examiner clarify the reasons for rejection.

Claim 36 requires that the first product related data be different than the second product related data. The Examiner concludes that this is "inherent." It can only be asked,

inherent to what, as PowerTV does not disclose either first product related data or second product related data.

Claim 41 requires the first product related data stored in the first and the second databases correspond to a preference of a user associated with the one network device. The Examiner argues that "the server stores the user's information accessible with a password." Yet again, the Examiner's reasoning is not understood. The Examiner provides no indication as to which server is being referred to, which portion of the PowerTV reference he finds to disclose this feature, or where the required correspondence to a preference of a user is to be found. Again, to the extent the rejection is maintained, the Examiner is courteously requested to clarify the rejection.

It is respectfully submitted, that for the above reasons, these dependencies of claim 29 further and independently distinguish from the applied art. Accordingly, it is respectfully requested that the Examiner reconsider and withdraw the rejection of these claims.

The Examiner has failed to provide any rationale for the rejection of dependent claims 42-47. AS best understood, the Examiner has failed to address these claims because of the misapplication of the Casey and Otto cases, discussed above. Accordingly, the Examiner is courteously requested to properly interpret and examine claims 42-47.

Claim 37, which depends from claim 29, stands rejected under 37 U.S.C. §102(b) as being anticipated by PowerTV, as applied above, or in the alternative, under 37 U.S.C. §103(a) as being obvious over PowerTV. The rejection is respectfully traversed.

The Examiner argues that a "second plurality of first servers and a third server are either directly or inherently disclosed since the network is connected to the Internet and

Internet applications may contain many servers." The Examiner further argues, "however, if not directly or inherently disclosed, it would have been obvious ... to modify PowerTV to include the duplicate servers," since "such a modification is a mere duplication of parts."

It is respectfully submitted that, again, the Examiner has not properly interpreted claim 37. Claim 37 requires more than just a second plurality of first servers and a third server. The servers are configured to perform specific functions, as recited in claim 37. The Examiner does not address these requirements, thus the Examiner has failed to properly examine claim 37.

Furthermore, the second plurality of first servers and the third server are not mere duplication of parts, as argued by the Examiner. MPEP §2144.04 VI B, to which the Examiner refers, cites In re Harza, 124 USPQ 378 (1960), as teaching that a mere duplication of parts to perform the same function should be given little patentable weight unless a new and unexpected result is produced.

As should be understood from the discussion above, PowerTV does not teach the required first plurality of first servers or the second server. Thus, even if the second plurality of first servers were a duplication of the first plurality of first servers, and even if the third server was a duplication of the second server, which they each are not, claim 37 would nonetheless patentably distinguish from PowerTV.

However, as is clear from a proper interpretation of claim 37, the second plurality of first servers and the third server are not mere duplications of parts. The second plurality of first servers perform a different function than the first plurality of first servers, namely, to communicate with a second plurality of network devices associated with a second network.

Also, the third server performs a different function than the second server, namely, to communicate with the second plurality of first servers. Accordingly, the Examiner is courteously requested to reconsider and withdraw the rejection of claim 37.

Claims 38-40, which depend from claim 29, stand rejected under 35 U.S.C. §103(a) as being obvious over PowerTV in view of Condon (U.S. Patent 5,956,714). The rejection is respectfully traversed.

It is first noted that in view of the deficiencies in the rejection of claim 29 based upon PowerTV, the addition of Condon cannot result in the claimed invention. Hence, for this reason alone the rejection should be withdrawn.

The Examiner acknowledges that PowerTV does not teach priority queues. The Examiner looks generally to Condon for such feature, though the Examiner has failed to provide any guidance as to where in Condon, or the applied combination, the requirements of claim 38-40 are disclosed. The Examiner rejects each of claims 38-40 with the omnibus statement "Condon teaches using priority based queues in a plurality of servers to increase efficiency in a database."

It is acknowledged that Condon teaches a technique for queuing. However, Condon does not teach or suggest the features of claims 38-40. For example, Condon does not disclose a low priority queue and a high priority queue, as required by claims 38-40. Rather, Condon teaches a single queue that includes prioritized items, one item in the queue having a higher priority than another item in the same queue (see, generally, column 4, lines 40-53). Furthermore, Condon does not teach or suggest different time periods associated with different queues, also as required by claims 38-40.

Also, Condon does not teach or suggest a high priority queue being a real time queue and a low priority queue being a

batch queue, as required by claim 39. Condon also does not teach or suggest the requirements of claim 40, i.e. that a product related request include information indicative of a response priority and that a product related request is queued by a first server based upon the indicated response priority.

Further, there is nothing with the applied art references to motivate their combination or to suggest how one could implement the proposed combination.

Accordingly, it is respectfully requested that the Examiner reconsider and withdraw the rejection of dependent claims 38-40 for at least this reason.

As should be clear from the discussion above, each of claims 48-60, which remain unexamined, also patentably distinguishes from the applied art, whether taken individually or in combination.

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed local telephone number, in order to expedite resolution of any remaining issues and further to expedite passage of the application to issue, if any further comments, questions or suggestions arise in connection with the application.

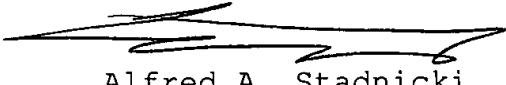
Docket No.: 3011-02

Client No.:

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 12-0429 and please credit any excess fees to such deposit account.

Respectfully submitted,

LALOS & KEEGAN



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**APPENDIX TO RESPONSE TO OFFICIAL ACTION DATED March 1, 2001**

**AMENDMENTS TO CLAIMS**

**(DELETIONS IN BRACKETS AND ADDITIONS UNDERLINED)**

37. A system architecture according to claim 29, further comprising:

a second plurality of the first servers, each configured to communicate with a second plurality of network devices associated with a second network, to receive a second product related request from one of the second plurality of network devices, to further transmit the received second product related request, to receive the second product related data in response to the further transmitted second product related request, and to transmit the received second product related data to that one network device in response to the received second product related request; and

a third server, having a third database storing the first and the second product related data, configured to receive the further transmitted second product related request, to transmit the stored second product related data to the one of the plurality of second servers from which that request is received, and to still further transmit the received second product related request;

wherein the central server is further configured to receive the still further transmitted second product related request and store that received request in the second database, and the first and the second product related data stored in the third database are the first and second product related data transmitted by the central server.